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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/387,513	09/01/1999	KIYOSHI TOYODA	P18445.P04	2687

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EXAMINER	
PARK, CHAN S	

ART UNIT	PAPER NUMBER
2622	

DATE MAILED: 04/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/387,513	TOYODA, KIYOSHI	
	Examiner	Art Unit	
	CHAN S PARK	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 April 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *13-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *13-18* is/are rejected.

7)☒ Claim(s) *13,16 and 18* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's **Request for a Continued Examination** was received on 4/5/04, and has been entered and made of record. Currently, **claims 13-18** are pending.

Response to Arguments

2. Upon review of the references of *Ohnishi et al. (U.S. Patent No. 5,655,152 hereinafter Ohnishi)* and *Ohto et al. (U.S. Patent No. 5,864,673 hereinafter Ohto)*, which was cited in the Office Action dated 11/19/03 under 35 U.S.C. 103 (a), as being unpatentable **claims 13-18**, the examiner notes that the references can still be interpreted as anticipating the claims, as currently amended.

Particularly, as amended, **claims 13, 16 and 18** now require "[obtaining] the capability of the receiving facsimile including one of resolution, a paper size, a compression format, and an encryption format that are utilized for a facsimile communication." The Applicant argues that the correspondence table of Ohnishi fails to store information regarding resolution that is utilized for a facsimile communication. However, the examiner notes that Ohnishi teaches the capability of the receiving facsimile including the resolution that is utilized for a facsimile communication in the correspondence table (col. 40, lines 52-54 & fig. 45(b)).

Furthermore, it should be noted that Ohto also discloses a terminal device having a media attribute-classified compression information storage unit for sharing its

compression information with other terminal devices connected over the network (col. 26, lines 31-37 & fig. 30).

Ohnishi and Ohto are analogous art because they are from the same field of endeavor, which is the network facsimile art.

Since it was the Ohnishi objective to provide a server to collect information of output units over the network and the reference teaches the data transmission and the information exchange between different servers over network (col. 2, lines 42-45), it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Ohto system of inquiring and receiving capabilities of desired output units like facsimiles with the network facsimile of Ohnishi.

The motivation for doing so would have been to prevent a futile communication by receiving capability information of a receiving facsimile prior to the transmission.

Therefore, it would have been obvious to combine Ohnishi with Ohto to obtain the invention as specified in **claims 13, 16 and 18**.

3. Therefore, the rejection of claims 13-18, as cited in the Office Action is maintained and repeated in this Office Action with the newly amended limitation incorporated.

Claim Objections

4. **Claims 13, 16 and 18** are objected to because of the following informalities: perhaps "a encryption" should be replaced with "an encryption". Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohnishi and in further view of Ohto.

5. With respect to claim 13, Ohnishi discloses an image communication apparatus (facsimile 24) connected with a receiving facsimile (one of unillustrated output units connected to the server 31) via a server apparatus (server 30) on the network (fig. 21), the image communication apparatus comprising:

a communicator configured to communicate with a first server apparatus (30) and a second server apparatus (31) via the network (col. 27, lines 42-48);

a controller, when the first server apparatus is determined not to store the receiving facsimile unit information, is configured to obtain, from the second server

apparatus, the information, and to store the obtained information of the receiving facsimile in the first server apparatus (col. 44, lines 36-57 & col. 46, lines 35-43),

wherein the capabilities of the receiving facsimile includes one of resolution, a paper size, a compression format, and an encryption format that are utilized for a facsimile communication (resolution in col. 40, lines 52-54 & fig. 45(b)).

Ohnishi teaches that the first server sends information request to other servers to retrieve the information of the destination output units such as printers and facsimiles connected to the latter servers.

It should be noted that the Examiner use fig. 21 to provide a better description of the Ohnishi twelfth embodiment.

According to fig. 21, a bidirectional communication arrow is shown between the server 30 and the facsimile 24. Although the detailed description of the embodiment does not explicitly disclose a communicator in the facsimile 24, it is inherent that an I/O port device or a communicator is included for data transmission between the two devices.

However, Ohnishi does not disclose expressly if the network can be the Internet and if the information of the output unit includes the capabilities regarding facsimile data that the receiving facsimile can receive.

Examiner takes Official Notice that the facsimile data transmission over the Internet is well known in the art.

Furthermore, Ohto, on the other hand, discloses a plurality of terminal devices including facsimile for both data and capabilities exchange. Prior to the data

transmission, an inquiry about the receiving device's capabilities is first requested and then stored in the sender's terminal device. The capabilities information includes what element data can be outputted by the terminal device (col. 18, lines 1-38). Ohto also discloses a local area network for connecting terminal devices in a group and a wide are network for connecting a plurality of groups each having a plurality of terminal devices (col. 14, lines 9-30). Further, Ohto discloses a terminal device having a media attribute-classified compression information storage unit for sharing its compression information with other terminal devices connected over the network (col. 26, lines 31-37 & fig. 30).

Ohnishi and Ohto are analogous art because they are from the same field of endeavor, which is the network facsimile art.

Since it was the Ohnishi objective to provide a server to collect information of output units over the network and Ohnishi teaches the data transmission and the information exchange between different servers over network (col. 2, lines 42-45), it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Ohto system of inquiring and receiving capabilities of desired output units like facsimiles with the network facsimile of Ohnishi.

The motivation for doing so would have been to prevent a futile communication by receiving capability information of a receiving facsimile prior to the transmission.

Therefore, it would have been obvious to combine Ohnishi with Ohto to obtain the invention as specified in claims 13.

6. With respect to claim 14, Ohnishi reference discloses the image communication apparatus wherein the first server apparatus is a local server apparatus in a local area

network containing the image communication apparatus, and the second serer apparatus is a global server apparatus in a global area network connected with the local area network (fig. 21). According to the invention, the servers 30, 31, and 32 can be read as both a local and global servers since they all communicate with local output units as well as with other servers. It should be noted that the Office read server 30 as a local server apparatus since it controls the local output units (printer 22 and facsimile 24) and server 31 as a global server apparatus in a global network since it communicates with other servers for the information exchange (col. 27, lines 42-49). Furthermore, Ohto, according to fig. 5, discloses terminal devices connected over both a local network (group 520) and a global network (511).

7. With respect to claim 15, Ohto discloses the server that stores the capabilities of the receiving facsimile in associated with an e-mail address of the receiving facsimile (col. 15, lines 21-25). The Office took the one of the groups (524) as a DNS server, which uses the method of transmitting a fax message in a standard e-mail format.

8. With respect to claim 16, Ohnishi discloses a server apparatus (server 30) connected with a transmitting facsimile (facsimile 24) and a receiving facsimile (one of unillustrated output units connected to the server 31) via the network, the server apparatus comprising:

a controller configured to obtain the capabilities of the receiving facsimile from another server apparatus that stores the capabilities of the receiving facsimile, when the capabilities of the receiving facsimile are not stored and when the transmitting facsimile

inquires regarding the capabilities of the receiving facsimile (col. 44, lines 36-57 & col. 46, lines 35-43),

wherein the capabilities of the receiving facsimile includes one of resolution, a paper size, a compression format, and an encryption format that are utilized for a facsimile communication (resolution in col. 40, lines 52-54 & fig. 45(b)).

Ohnishi teaches that the first server sends information request to other servers to retrieve the information of the destination output units such as printers and facsimiles connected to the latter servers.

It should be noted that the Examiner use fig. 21 to provide a better description of the Ohnishi twelfth embodiment.

However, Ohnishi does not disclose expressly if the network can be the Internet and if the information of the output unit includes the capabilities regarding facsimile data that the receiving facsimile can receive. Also, it does not disclose expressly if the server has a memory configured to store information regarding the output units.

Examiner takes Official Notice that the facsimile data transmission over Internet is well known in the art.

Furthermore, Ohto, on the other hand, discloses a plurality of terminal devices including facsimile for both data and capabilities exchange. Prior to the data transmission, an inquiry about the receiving device's capabilities is first requested and then stored in the memory (outputable media attribute information storage unit 516) in the sender's terminal device. The capabilities information includes what element data can be outputted by the terminal device (col. 18, lines 1-38). Ohto also discloses a local

area network for connecting terminal devices in a group and a wide area network for connecting a plurality of groups each having a plurality of terminal devices (col. 14, lines 9-30). Further, Ohto discloses a terminal device having a media attribute-classified compression information storage unit for sharing its compression information with other terminal devices connected over the network (col. 26, lines 31-37 & fig. 30).

Ohnishi and Ohto are analogous art because they are from the same field of endeavor, which is the network facsimile art.

Since it was the Ohnishi objective to provide a server to collect information of output units over the network and Ohnishi teaches the data transmission and the information exchange between different servers over network (col. 2, lines 42-45), it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Ohto system of inquiring and storing capabilities of desired output units like facsimiles in a memory with the network facsimile of Ohnishi.

The motivation for doing so would have been to prevent a futile communication by receiving capability information of a receiving facsimile prior to the transmission.

Therefore, it would have been obvious to combine Ohnishi with Ohto to obtain the invention as specified in claim 16.

9. With respect to claim 17, the combined reference discloses the server apparatus according to claim 16, wherein the controller obtains the capabilities of the receiving facsimile from a further server apparatus, when the another server apparatus does not store the capabilities of the receiving facsimile (col. 46, lines 35-43). It should be noted that Ohnishi discloses the method of broadcasting the information request. The

method, therefore, obtains the capabilities of the receiving facsimile from another server apparatus, when the second server apparatus does not store the capabilities of the receiving facsimile.

10. With respect to claim 18, Ohnishi discloses an information exchanging method for controlling an image communication apparatus (facsimile 24) connected with a first server apparatus (server 30) and a second server apparatus (server 31) via the network (fig. 21), at least one of the first server apparatus and the second server apparatus storing information regarding facsimile data that a receiving facsimile is capable of receiving (col. 44, lines 36-57 & col. 46, lines 35-43), the capability exchanging method comprising:

obtaining, from the second server apparatus, information regarding facsimile data that the receiving facsimile is capable of receiving;

storing (updating) the information regarding the information of the receiving facsimile in the first server apparatus, when the first server apparatus is determined not to store the information regarding the information of the receiving facsimile (col. 44, lines 36-57 & col. 46, lines 35-43),

wherein the capabilities of the receiving facsimile includes one of resolution, a paper size, a compression format, and an encryption format that are utilized for a facsimile communication (resolution in col. 40, lines 52-54 & fig. 45(b)).

The reference teaches that the first server sends information request to other servers to retrieve the information of the destination output units such as printers and facsimiles connected to the latter servers.

It should be noted that the Examiner use fig. 21 to provide a better description of the Ohnishi twelfth embodiment.

It should be further noted that it is the Ohnishi objective to find appropriate and capable facsimile for receiving facsimile data.

However, Ohnishi reference does not disclose expressly if the network can be the Internet and if the information of the output unit includes the capabilities regarding facsimile data that the receiving facsimile can receive.

Examiner takes Official Notice that the facsimile data transmission over Internet is well known in the art.

Furthermore, Ohto, on the other hand, discloses a plurality of terminal devices including facsimile for both data and capabilities exchange. Prior to the data transmission, an inquiry about the receiving device's capabilities is first requested and then stored in the sender's terminal device. The capabilities information includes what element data can be outputted by the terminal device (col. 18, lines 1-38). Ohto also discloses a local area network for connecting terminal devices in a group and a wide area network for connecting a plurality of groups each having a plurality of terminal devices (col. 14, lines 9-30). Additionally, Ohto discloses a terminal device having a media attribute-classified compression information storage unit for sharing its compression information with other terminal devices connected over the network (col. 26, lines 31-37 & fig. 30).

Ohnishi and Ohto are analogous art because they are from the same field of endeavor, which is the network facsimile art.

Since it was another Ohnishi objective to provide a server to collect information of output units over the network and the reference teaches the data transmission and the information exchange between different servers over network (col. 2, lines 42-45), it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Ohto system of inquiring and receiving capabilities of desired output units like facsimiles with the network facsimile of Ohnishi.

The motivation for doing so would have been to prevent a futile communication by receiving capability information of a receiving facsimile prior to the transmission.

Therefore, it would have been obvious to combine Ohnishi with Ohto to obtain the invention as specified in claim 18.

Contact Information

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S PARK whose telephone number is (703) 305-2448. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chan S. Park
Examiner
Art Unit 2622

csp
April 21, 2004

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